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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/604,924

08/27/2003

David M. List

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07/31/2006

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EXAMINER

AIRAPETIAN, MILA

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/604,924

Applicant(s)

LIST ET AL.

Examiner

Mila Airapetian

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>08/27/03, 01/12/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Preliminary Notes.**

For the purpose of examination, Examiner understands the phrase "communicating said data to an Internet website and accessing said data to determine applicable royalty payments due" as "posting said data the website and accessing said website".

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "said case". There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim 1, 8-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Ramachandran et al. (US 2001/0044747).**

**Claim 1.** Ramachandran et al. (Ramachandran) teaches a method for dispensing digital information from an automated transaction machine, comprising the steps of:

accessing a terminal, said terminal having access to at least one recorded item and including at least one storage medium [0047];

selecting at least one of said at least one recorded item [0047];

adding said selected at least one recorded item to a list [0057];

recording said at least one selected item to said storage medium [0030]; and

dispensing said storage medium [0043].

**Claim 8.** Ramachandran teaches said method further comprising the step of recording data on a data collection server ("*... connected computer is operative to keep records of each dispense of digital content*") [0062].

**Claim 9.** Ramachandran teaches said method further comprising the step of accessing the recorded data [0033].

**Claim 10.** Ramachandran teaches a system for dispensing digital information from an automated transaction machine, comprising:

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a terminal having access to recorded material and configured to download recorded material selected by a user to a storage medium [0047]; and a

dispenser connected to said terminal configured to distribute said storage medium having said selected recorded material recorded thereon [0043].

**Claim 11.** Ramachandran teaches said system wherein said terminal includes a hard drive with recorded material stored therein [0051].

**Claim 12.** Ramachandran teaches said system wherein said terminal is communicatively connected to a supply server having recorded material stored therein [0047].

**Claim 13.** Ramachandran teaches said system wherein said terminal is communicatively connected to an Internet [0043].

**Claim 14.** Ramachandran teaches said system wherein said supply server is communicatively connected to an Internet [0043].

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 15, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramachandran et al. (US 2001/0044747) in view of Pollak (US 2003/0004833).**

**Claim 20.** Ramachandran teaches a method for dispensing digital information from an automated transaction machine, comprising the steps of:

selecting at least one recorded item from a list of recorded items available for purchase [0047];

purchasing said at least one recorded item [0070];

However Ramachandran does not teach:

collecting sales data on a server related to the quantity of sales;

communicating sales data to an internet website; and

accessing said data to determine applicable royalty payments due.

Pollak et al. (Pollak) teaches a method for vending electronic entertainment including collecting sales data on a server related to the quantity of sales; communicating sales data to an internet website; and accessing said data to determine applicable royalty payments due ([0010], page 3, claim 1-2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ramachandran to include collecting sales data on a server related to the quantity of sales; communicating sales data to an internet website;

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and accessing said data to determine applicable royalty payments due, as disclosed in Pollak, because it would advantageously allow to stimulate content providers to supply their digital content.

**Claim 15.** Ramachandran teaches all the limitations of claim 15 except that said terminal is communicatively connected to a data collection server.

Pollak teaches a system for vending electronic entertainment terminal is communicatively connected to a data collection server ([0010], page 3, claim 1-2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ramachandran to include that said terminal is communicatively connected to a data collection server, as disclosed in Pollak, because it would advantageously allow to stimulate content providers to supply their digital content.

**Claim 16.** Ramachandran teaches all the limitations of claim 16 except that said data collection server is communicatively connected to a website accessible by third parties.

Pollak teaches a system for vending electronic entertainment terminal wherein said data collection server is communicatively connected to an Internet (page 3, claim 1-2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ramachandran to include that said data collection server

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is communicatively connected to an Internet, as disclosed in Pollak, because it would advantageously allow to stimulate content providers to supply their digital content.

**Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramachandran in view of Parker (US 4,703,465).**

**Claim 3.** Ramachandran teaches all the limitations of claim 3 except designing a label; and printing said label on one of a protective case and said storage medium.

Parker teaches a method for producing an audio magnetic tape recording from a music library wherein the specific label for the cassette is printed (col. 1, lines 55-56, col. 4, lines 42-45)).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ramachandran to include a feature of printing a label, as disclosed in Parker, because it would advantageously allow the user to readily recognize the content of the digital content without using the medium thereby facilitating management of the recorded file.

**Claim 4.** Ramachandran teaches all the limitations of claim 4 except including said list on said label.

Parker teaches a method for producing an audio magnetic tape recording from a music library wherein said list is included on said label (col. 4, lines 42-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ramachandran to include that said list is included on said



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label, as disclosed in Parker, because it would advantageously allow the user to readily recognize the content of the digital content without using the medium thereby facilitating management of the recorded file.

**Claim 5.** Ramachandran teaches said method further comprising the step of selecting a payment type [0062].

**Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ramachandran in view of Rosenberg (US 6,363,357).**

**Claim 2.** Ramachandran teaches all the limitations of claim 2 except previewing said selected at least one recorded item.

Rosenberg teaches a method for selling a digital content product in an online commercial transaction wherein the buyer may preview the product before purchasing (col. 5, line 63).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ramachndran to include previewing selected item, as disclosed in Rosenberg, because it would advantageously allow to avoid possible mistakes by purchasing wrong items.

**Claim 17.** Ramachandran teaches a system for dispensing digital information from an automated transaction machine wherein said data collection server ("... *or other*

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*connected computer*") is communicatively connected to a website accessible by third parties [0066].

**Claim 18.** Ramachandran teaches said system wherein said data collection server collects data related to quantity of sales of said selected recorded materials [0062], [0066].

**Claim 19.** Ramachandran teaches said system wherein said third parties are copyright owners [0066].

**Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ramachandran in view of Kamen et al. (US 5,135,012).**

**Claim 6.** Ramachandran teaches all the limitations of claim 6 except affixing a magnetic strip to said case.

Kamen et al. (Kamen) teaches a magnetic compact case wherein magnetic strip is affixed to the compact case (col. 7, lines 55-58).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ramachandran to include affixing a magnetic strip to said case, as disclosed in Kamen, because it would advantageously allow to releasably attach various product to said case thereby providing convenience to the customer (col. 2, lines 4-8).

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**Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ramachandran and Kamen, as applied to claim 6, in view of Cho (US 2004/0064374).**

**Claim 7.** The combination of Ramachandran and Kamen teaches all the limitations of claim 7 except of the step of paying a cashier.

Cho teaches a method for retail distribution of customized media content including paying a cashier for the downloaded songs [0035].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Ramachandran and Kamen to include paying a cashier feature, as disclosed in Cho, because it would advantageously allow to obtain this product in a store.

### ***Response to Arguments***

In respect to Applicant's request, filed 05/16/2006, to reconsider the Election/Restriction of 03/17/2006 have been fully considered and are persuasive. Therefore, the Election/Restriction of 03/17/2006 has been withdrawn.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

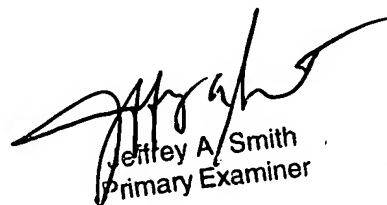
(i) US 2004/0064374 to Cho discloses a network-based system and method for retail distribution of customized media content.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mila Airapetian whose telephone number is (571) 272-3202. The examiner can normally be reached on Monday-Friday 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MA



Jeffrey A. Smith  
Primary Examiner